

200208971-1

10/645,185

REMARKS

This is a full and timely response to the final Official Action mailed November 13, 2007 (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

No amendments to the application are proposed by the present paper. Thus, claims 1-33 are currently pending for further action.

Remarks:

In the most recent response by the Applicant, dated August 21, 2007, a declaration under 37 CFR 1.131 was submitted showing conception of the subject matter claimed in this application at least as early as Sept. 23, 2002 by the inventor, Winthrop Childers, within the United States. This conception date, established by the declaration under Rule 131, is prior to the effective dates of cited references U.S. Patent App. Pub. No. 2004/0064355 to Dorenbosh et al ("Dorenbosh") and U.S. Patent App. Pub. No. 2004/0039723 to Lee et al ("Lee"). The effective date of Dorenbosh as a prior art reference under 35 U.S.C. § 102(e) is the filing date of the reference, Oct. 1, 2002. Similarly, the effective date of Lee as a prior art reference under 35 U.S.C. § 102(e) is its filing date, April 3, 2003.

The declaration filed under Rule 131 further showed activities undertaken by the Applicant from conception to constructive reduction to practice (i.e., the filing of the present application) on August 21, 2003. Additionally, Applicant respectfully submits that the disclosure document which was generated prior on or before September 23, 2002 is a complete description of the claimed subject matter such that one of skill in the art could

200208971-1

10/645,185

practice the claimed subject matter from that document. Consequently, Applicant may be considered to have achieved an actual reduction to practice of the claimed subject matter on or before September 23, 2002.

In the most recent Office Action, dated Nov. 13, 2007, the Examiner rejected the Applicant's Rule 131 declaration saying that: "The absence of activity between the dates of Sept. 23, 2002 and April 3, 2003 does not prove that due diligence was taken toward constructive reduction to practice." Applicant respectfully submits that this is both incorrect as a matter of law and a misapplication of Rule 131.

Firstly, the inventor has acknowledged in the declaration that all statements in the declaration are true and, if false, would be subject to punishment under 18 U.S.C. § 1001. (Declaration of 8/17/07, Para. 14). In the declaration, the inventor expressly states that he, the inventor, prior to October 1, 2002, "I conceived of my invention and diligently worked toward constructively reducing my invention to practice by filing U.S. Application No. 10/645,185 on August 21, 2003." (*Id.* Para. 4).

The Examiner has not provided any basis or reasoning for doubting this declared statement of the invention that acts demonstrating adequate diligence occurred during the time period in question. This is legally improper. It has been held that, due to the Applicant's duty of candor, the Patent Office is required to give weight to all statements and data in the specification or a declaration as factual evidence of patentability. *In re Soni* 34 USPQ2d 1684 (Fed. Cir. 1995). Consequently, the Examiner may not simply disregard the Inventor's declared statement that the required diligence existed during the time period in question. For at least this reason, the cited prior art references should be withdrawn from consideration as valid prior art.

Additionally, the Office Action misconstrues and misapplies Rule 131.

200208971-1

10/645,185

37 C.F.R. 131 states:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or **conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.**

(Emphasis added).

Thus, to eliminate the cited references from consideration as valid prior art, the Applicant only need show (1) **conception prior to the effective date** and (2) **due diligence from prior to said date** (the effective date of the reference) **to a subsequent reduction to practice or to the filing of the application.**

Consequently, the correct application of the Rule to the cited prior art would be as follows:

- 1) US 2004/006355 to Dorenbosch et al.: conception should be shown prior to Oct. 1, 2002 and due diligence from just before Oct. 1, 2002 until an actual reduction to practice or Aug. 21, 2003.
- 2) US 2004/0039723 to Lee et al.: conception should be shown prior to April. 3, 2003 and due diligence from just before April 3, 2003 until an actual reduction to practice or Aug. 21, 2003.

If the language of Rule 131 is correctly applied, the Applicant submits that Dorenbosch and Lee should be eliminated from consideration as valid prior art based on the previously submitted Rule 131 declaration.

200208971-1

10/645,185

In the case of Lee, Applicant must show diligence from just before April 3, 2003 to an actual reduction to practice or August 21, 2003. If the disclosure document produced by Applicant on or before September 23, 2002 is recognized as an actual reduction to practice, Lee is clearly not valid prior art against the present application under Rule 131 and Applicant previously-filed declaration. Alternatively, Applicant would need to show diligence during the four month period from April 3, 2003 to August 21, 2003.

As will be readily appreciated by those engaged in U.S. patent practice, a four month period is a perfectly reasonable period during which an applicant may work with an attorney to draft and file a patent application, such as occurred in this case on August 21, 2003.

Turning again to the Inventor's Declaration under Rule 131, the Inventor expressly states "[f]ollowing my conception prior to October 1, 2002, I worked diligently with the Patent Attorney, Leland Wiesner, Esq. to prepare the patent application filed on August 21, 2003 thereby constructively reducing the invention to practice. During this time period, the patent attorney prepared one or more drafts of the application for my comment. With my comments, the patent attorney revised one or more portions of the application, claims and/or figures to accommodate my suggestions." (Declaration of 8/17/07, Para. 6).

This statement clearly demonstrates acts of diligence during the time period in question. Consequently, there is no reasonable basis for questioning Applicant's diligence during the time period in question.

Therefore, Lee should clearly be eliminated from consideration as a valid prior art reference in this matter.

Additionally, should it become necessary, it is anticipated that additional details and activities could be shown that provide evidence of diligence during the time periods in question. In particular, it is anticipated that the required diligence from just prior to April 3,

200208971-1

10/645,185

2003 until constructive reduction to practice on August 21, 2003 can be shown through an additional declaration if necessary. During this period of time, it is anticipated that there are ample affirmative acts and/or acceptable excuses to show the required diligence, such as docketing, prior art searches, attorney client communications, drafting, reviewing, and filing of the application. The approximately four to five months between April 3, 2003 and August 21, 2003 is a reasonable time frame for these actions.

Prior Art:

Claims 1-33 were rejected under 35 USC §103(a) as being unpatentable over Lee et. al [2004/0039723] in combination with other references. As discussed above, if 37 C.F.R. 1.131 is correctly applied, the previously filed affidavit should be sufficient to eliminate Lee et. al [2004/0039723] from consideration as valid prior art. Consequently, all the rejections made in the recent Office Action, all of which rely on Lee, are rendered moot.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally,

200208971-1

10/645,185

nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 11 January 2008

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on January 11, 2008. Number of Pages: 17



Cami L. Jones